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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,945	08/03/2001	Jonathan R. Belk	100.133US01	9187

7590 03/08/2005

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EXAMINER	
SHAH, CHIRAG G	

ART UNIT	PAPER NUMBER
2664	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/921,945	BELK ET AL.	
	Examiner	Art Unit	
	Chirag G Shah	2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23,32-40 and 43-60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *24-31 and 42* is/are allowed.

6)☒ Claim(s) *1,10-14,19-23,32,35-37,43,48-52,56 and 57* is/are rejected.

7)☒ Claim(s) *2-9,15-18,33,34,38-40,44-47,53-55 and 58-60* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *2/16/05*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Minor Informalities

1. Claim 13 objected to because of the following informalities: A typo has occurred in the formula of claim 13. Examiner believes the formula should be F(RTS') not F(R'TS) based on comparison. Appropriate correction is required.

2. Claim 42 objected to because of the following informalities: After the claim 42 ends, "From 100.118:" is written by error. Appropriate correction is required.

Cancelled Claims

3. Authorization for this examiner to cancel claims 41 and 60-63 was given in a telephone interview with Mr. David Fogg on 02/16/05.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1, 10, 11, 12, 13, 14, 19-21, 22-25, 32, 36, and 37, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 13, 18-19, 24-26, 28, and 30-32 of U.S. Patent No. 6,363,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Referring to applicant's claim 1, Applicant merely broadens the scope of the claim 1 of patent number 6,363,073 by eliminating the terms: "based on the RTS values removed from the data packets," and further replacing "...of a period of time" to "...for each of a plurality of time periods." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claims 14 and 19, the combination of claims 14 and 19 of the present application is identical to claim 13 of U.S. Patent No. 6,363,073 except Applicant merely broadens the scope of claim 13 by replacing "a period of time" with "a plurality of time periods." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claim 32, Applicant merely broadens the scope of the claim 24 of patent number 6,363,073 by replacing "a period of time" with "a plurality of time periods." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claim 36, Applicant merely broadens the scope of the claims 28, 29, and 31 of patent number 6,363,073 by replacing "a period of time" with "a plurality of time periods." It

has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claim 10 of the present application are identical to claim 2 respectively of U.S Patent No. 6,363,073.

Referring to claim 11 of the present application are identical to claim 3 respectively of U.S Patent No. 6,363,073.

Referring to claim 12 of the present application are identical to claim 4 respectively of U.S Patent No. 6,363,073.

Referring to claim 13 of the present application are identical to claims 5 and 32 respectively of U.S Patent No. 6,363,073.

Referring to claim 20 of the present application are identical to claim 14 respectively of U.S Patent No. 6,363,073.

Referring to claim 21 of the present application are identical to claim 7 respectively of U.S Patent No. 6,363,073.

Referring to claim 22 of the present application are identical to claim 8 respectively of U.S Patent No. 6,363,073.

Referring to claim 23 of the present application are identical to claim 4 respectively of U.S Patent No. 6,363,073.

Referring to claim 35 of the present application are identical to claim 26 respectively of U.S Patent No. 6,363,073.

Referring to claim 37 of the present application are identical to claim 30 respectively of U.S Patent No. 6,363,073.

6. Claim 1, 10, 11, 12, and 13, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 11 of U.S. Patent No. 6,157,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Referring to applicant's claim 1, Applicant merely broadens the scope of the claim 1 of patent number 6,157,646 by eliminating the terms: "based on the RTS values removed from the data packets," and further replacing "...of a period of time" to "...for each of a plurality of time periods." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claim 10 of the present application are identical to claim 2 respectively of U.S Patent No. 6,157,646.

Referring to claim 11 of the present application are identical to claim 3 respectively of U.S Patent No. 6,157,646.

Referring to claim 12 of the present application are identical to claim 4 respectively of U.S Patent No. 6,157,646.

Referring to claim 13 of the present application are identical to claims 11 respectively of U.S Patent No. 6,157,646.

7. Claims 43, 49-52 and 56-57, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,721,328. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Referring to claim 43, Applicant merely broadens the scope of the claims 1 of patent number 6,721,328 by eliminating, "wherein identifying a relative maximum fill level comprises comparing read and write address for the buffer and updating a register for a period of time when a buffer fill level, based on the difference between the read and write addresses is larger than a value previously stored in the register and further replacing "a first period of time" with "a plurality of time periods." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claim 49, Applicant merely broadens the scope of the claims 8 and 17 of patent number 6,721,328 by eliminating, "a reassembler, wherein the reassember receives data packets from the telecommunications network." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Referring to claim 48 of the present application are identical to claim 5 respectively of U.S Patent No. 6,721,328.

Referring to claim 50 of the present application are identical to claim 10 respectively of U.S Patent No. 6,721,328.

Referring to claim 51, Applicant merely narrows the scope of the claims 5 of patent number 6,721,328 by eliminating, "stores the maximum buffer fill level observed over a period of time." It has been held that the addition of an element and its function is an obvious expedient if the remaining elements perform the same function before.

Referring to claim 52 of the present application are identical to claim 19 respectively of U.S Patent No. 6,721,328.

Referring to claims 56-57, the combination of claims 56-57 of the present application is identical to claim 14 of U.S. Patent No. 6,721,328 except Applicant merely broadens the scope of claim 14 by replacing "a period of time" with "a plurality of time periods." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Applicant is advised that should claims 56-57 be found allowable, claims 56-57 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

10. Claims 24-31, 42 allowed.

11. Claims 2-9, 15-18, 33-34, 38-40, 44-47, 53-55, and 58-60 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703)305-3988, (for formal communications intended for entry)

Or:

(703)305-3988 (for informal or draft communications, please label "Proposed" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag G Shah whose telephone number is 571-272-3144. The examiner can normally be reached on M-F 6:45 to 4:15, 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cgs
February 17, 2005

Ajit Patel
Primary Examiner